

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

### **REMARKS**

Claims 1-34 are pending in the instant application. In the Office Action mailed July 27, 2004, the Examiner rejects claims 1-8, 12-20, and 22-32, and the Examiner objects to claims 9-11 and 21. Applicants note, however, that the Examiner did not cite any basis for rejecting claims 13 and 23.

By virtue of the amendments to the claims presented above, independent claims 1, 39, 44, and 51 are amended. New claims 33 and 34 are presented; new claim 33 represents a combination of the subject matter of original claims 1 and 9-11, and new claim 34 represents a combination of the subject matter of original claims 1 and 21. Based on the amendments and remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

#### **1. Remarks on Paragraphs 2-13 of the Office Action mailed on July 27, 2004: Rejection of Claims 1-6, 8, 12, 14-15, 20, 22, 24, and 26-28 Under 35 U.S.C. §102(b)**

In the Office Action mailed July 27, 2004, the Examiner rejects claims 1-6, 8, 12, 14-15, 20, 22, 24, and 26-28 as being unpatentable under 35 U.S.C. §102(b) over U.S. Patent No. 5,524,575 issued to Lennon (hereinafter "the Lennon patent").

With respect to claims 1 and 27, the Examiner believes the Lennon patent discloses a first layer (see rubber layer 42 resting on palm area of glove in figure 5A) having a first layer perimetric edge, and wherein the first material is hook material having hooks 43 (see col. 3, lines 24-28 which describe the various shapes of element 43 – Examiner asserts that "undulations (e.g., ridges and valleys)" could be interpreted as "hooks") adapted to capture detritus; and a second layer 41 wherein the the second layer has a second layer perimetric edge and wherein at least a portion of the second layer perimetric edge is coupled to the first layer (fig 5B) such that the first and second layers define a bag-like space that is at least partially enclosed (see fig 5A).

Claim 1 is directed to an animal shedding control device including a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus; a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed. First, as described in the Lennon patent at col. 3, lines 25-26, the palm portion 41 "is formed of, or faced by, latex or other soft rubber 42." Contrary to the Examiner's assertion, elements 41 and 42 in the Lennon patent do not and cannot define a bag-like space that is at least partially enclosed,

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

because elements 41 and 42 are either attached to one another ("faced by") or are actually the same element ("formed of"). Second, the Lennon patent does not disclose hooks in any form. Element 43 is described at col. 3, lines 27-28 as short fingers, teeth, bristles, or undulations. None of these disclose or even imply "hooks" as described by the Applicants at page 3 of the instant application.

Claim 27 is directed to a method for controlling animal shedding, the method including donning a mitt having a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus, and a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed; and petting an animal having detritus such that detritus is captured in the hooks; and disposing of the mitt. As stated above, and contrary to the Examiner's assertion, elements 41 and 42 in the Lennon patent do not and cannot define a bag-like space that is at least partially enclosed, because elements 41 and 42 are either attached to one another ("faced by") or are actually the same element ("formed of"). Second, the Lennon patent does not disclose hooks in any form. Element 43 is described at col. 3, lines 27-28 as short fingers, teeth, bristles, or undulations. None of these disclose or even imply "hooks" as described by the Applicants at page 3 of the instant application.

With respect to claim 2, the Examiner believes that the Lennon patent discloses that the first material is a micro-hook material (col. 3, line 25 discloses the use of "Velcro"). Claim 2 is directed to the device of claim 1, wherein the first material is micro-hook material. First, contrary to the Examiner's assertion, the Lennon patent does not disclose the use of "Velcro" on the palm portion. At col. 3, lines 23-25, the Lennon patent describes a simple version of its mitt in the form of a palm portion with strips or side bands, where the strips or side bands are "secured" or closed using "Velcro." Second, where the Lennon patent alludes to the use of "Velcro" as a closure for strips or bands, the simple mention of "Velcro" does not disclose an embodiment in which the first material is a micro-hook material, and the trademark "Velcro" does not disclose micro-hook material as defined by the Applicants at page 3 of the instant application.

With respect to claims 3 and 4, the Examiner believes that the Lennon patent discloses a second material that is a nonwoven, elastomeric material (col. 3, lines 25-28 disclose "latex or other soft rubber"). Claim 3 is directed to the device of claim 1, wherein the second material is a nonwoven material. First, the Examiner has already asserted with respect to independent claim 1

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

that the first material associated with the first layer (as both are defined by the Examiner) of the Lennon patent is "latex or other soft rubber." The second material is associated with the second layer (defined as the mitt by the Examiner), the material of which is not disclosed by the Lennon patent. In addition, "latex or other soft rubber" is not a nonwoven material. Claim 4 is directed to the device of claim 1, wherein the second material is an elastomeric material. Again, the Examiner has already asserted with respect to independent claim 1 that the first material associated with the first layer (as both are defined by the Examiner) of the Lennon patent is "latex or other soft rubber." The second material is associated with the second layer (defined as the mitt by the Examiner), the material of which is not disclosed by the Lennon patent. The Lennon patent does not disclose making the mitt from an elastomeric material.

With respect to claim 5, the Examiner believes the Lennon patent discloses the use of "Velcro" in the palm of the mitt (col. 3, line 25). Claim 5 is directed to the device of claim 1, wherein the second material is micro-hook material. As stated above, and contrary to the Examiner's assertion, the Lennon patent does not disclose the use of "Velcro" on the palm portion. At col. 3, lines 23-25, the Lennon patent describes a simple version of its mitt in the form of a palm portion with strips or side bands, where the strips or side bands are "secured" or closed using "Velcro." Second, where the Lennon patent alludes to the use of "Velcro" as a closure for strips or bands, the simple mention of "Velcro" does not disclose an embodiment in which the first material is a micro-hook material, and the trademark "Velcro" does not disclose micro-hook material as defined by the Applicants at page 3 of the instant application. Finally, The Examiner has defined the second material in the Lennon patent to be the mitt itself. The Lennon patent would have no reason to make the mitt from micro-hook material and then cover it with the "latex or other soft rubber" palm portion.

With respect to claim 6, the Examiner believes the Lennon patent discloses that the device is a mitt. Claim 6 is directed to the device of claim 1, wherein the device is a mitt. Claim 6 is a dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 1.

With respect to claim 8, the Examiner believes the Lennon patent discloses that the device can be used as a tool cover. Claim 8 is directed to the device of claim 1, wherein the device is a grooming tool cover. Claim 8 is a dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 1.

With respect to claim 12, the Examiner believes the Lennon patent discloses a thumb space. Claim 12 is directed to the device of claim 1, further comprising a thumb space. Claim 12 is a

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 1.

With respect to claims 14 and 15, the Examiner believes the Lennon patent discloses that the first layer (which includes the "hook" surface) includes adhesive (col. 3, line 4 discloses that the rubber surface has "a higher coefficient of friction" which would act as an adhesive). Claim 14 is directed to the device of claim 1, wherein the first layer further includes adhesive. Claim 15 is directed to the device of claim 14, wherein the adhesive is positioned on the hook material. First, claims 14 and 15 include the elements of claim 1. As such, the first layer of claims 14 and 15 includes hook material and further includes adhesive, indicating that these two elements are not the same material. Claim 15 makes this explicit with the adhesive positioned on the hook material. Second, the Lennon patent at col. 2, lines 18-22 indicates the the latex or other soft rubber has a high coefficient of friction, at least in comparison to the uncoated plastic or wire teeth or bristles of a comb or a brush. The Lennon patent further explains at col. 3, lines 1-5, however, that the higher coefficient of friction is due to the rough surface and compressibility of the latex or other soft rubber. The latex or other soft rubber as disclosed by the Lennon patent is not an adhesive; the Examiner has not provided evidence that it is.

With respect to claim 20, the Examiner believes the Lennon patent discloses that the device is disposable. Claim 20 is directed to the device of claim 1, wherein the device is disposable. Claim 20 is a dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 1.

With respect to claims 22 and 24, the Examiner believes the Lennon patent discloses that the device is sized to enclose a human hand or a grooming tool. Claim 22 is directed to the device of claim 1, wherein the space is sized to substantially enclose a human hand. Claim 24 is directed to The device of claim 1, wherein the space is sized to enclose a portion of a grooming tool. Claims 22 and 24 are dependent claims that depend from an allowable independent claim, and are thus allowable themselves for the reasons stated above with respect to claim 1.

With respect to claims 26 and 28, the Examiner believes the Lennon patent discloses a bag-like body 40 including an outer surface including micro-hook material and an interior space. Claim 26 is directed to a shedding control device including a bag-like body including an outer surface including micro-hook material; and an interior space, wherein the body is adapted to be turned inside-out to create a second interior space. As stated above, and contrary to the Examiner's assertion, the Lennon patent does not disclose the use of micro-hook material or even the use of "Velcro" on the outer surface. At col. 3, lines 23-25, the Lennon patent describes a

Appl. No. 10/748,645  
Arndt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

simple version of its mitt in the form of a palm portion with strips or side bands, where the strips or side bands are "secured" or closed using "Velcro." Second, where the Lennon patent alludes to the use of "Velcro" as a closure for strips or bands, the simple mention of "Velcro" does not disclose an embodiment in which the outer surface includes a micro-hook material, and the trademark "Velcro" does not disclose micro-hook material as defined by the Applicants at page 3 of the instant application. Further, the Lennon patent does not disclose an outer surface including micro-hook material because the palm portion of the device in the Lennon patent is "is formed of, or faced by, latex or other soft rubber 42," and such materials are not used to make micro-hook material as defined by the Applicants at page 3 of the instant application.

Claim 28 is directed to the method of claim 27, further comprising turning the mitt inside-out to enclose the detritus. Claim 28 is a dependent claim that depends from an allowable independent claim, and is thus allowable itself for the reasons stated above with respect to claim 27.

In view of the remarks set forth in this section, Applicants respectfully submit that claims 1-6, 8, 12, 14-15, 20, 22, 24, and 26-28 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

**2. Remarks on Paragraphs 15-23 of the Office Action mailed on July 27, 2004: Rejection of Claims 7, 30, and 31 as Obvious**

In the Office Action mailed July 27, 2004, the Examiner rejects claims 7, 30, and 31 as being unpatentable under 35 U.S.C. §103(a) over the Lennon patent in view of U.S. Patent No. 5,724,911 to McAlister ("the McAlister patent"). Applicants respectfully traverse the rejection.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The Examiner bears the initial burden of establishing the *prima facie* case. See In re Piasecki, 223 U.S.P.Q. 785,787, 745 F.2d 1468, 1471 (Fed. Cir. 1984).

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

1. The Examiner has not met the burden of establishing prima facie obviousness by failing to identify the motivation in the Lennon patent for modifying its teachings with the teachings of the McAllister patent.

Claim 7 is directed to an animal shedding control device including a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus; and a second layer including a second material, wherein the second layer has a second layer perimetric edge, wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, and wherein the device is a pet bed enclosure. Claim 30 is directed to a method for controlling animal shedding, the method including placing a device over an animal bed, the device having a first layer including a first material, wherein the first layer has a first layer perimetric edge, and wherein the first material is hook material having hooks adapted to capture detritus, and a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed; allowing an animal to use the bed such that detritus is captured in the hooks; removing the device from the bed; and disposing of the device. Claim 31 is directed to the method of claim 30, further comprising turning the device inside-out to enclose the detritus. Neither of the two cited references (the Lennon patent and the McAllister patent) disclose the claimed devices. The Examiner improperly "picked and chose" the components from the two references using the claimed invention as a template in order to form the rejection.

In the Office Action mailed July 27, 2004, the Examiner states "It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of McAllister of a sheet of nonwoven material to cover a pet's bed to the grooming device disclosed by Lennon in order to make grooming of the animal possible in the most passive and non-invasive manner for the animal." In this Office Action, the Examiner attempts to provide an explanation of the motivation for combining the references. The Examiner's explanation is insufficient. The sole motivation asserted by the Examiner, one of making "grooming of the animal possible in the most passive and non-invasive manner for the animal," does not appear in either of the cited patents. There is, therefore, no motivation within the patents to apply the teachings of one to the other. The Examiner does not adequately state why one of ordinary skill would read the Lennon patent and then look to the McAllister patent to convert the device to the another device to arrive at the device and method of claims 7, 30, and 31.

Appl. No. 10/748,645  
 Amdt. dated October 27, 2004  
 Reply to Office Action of July 27, 2004

Further, the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). The Examiner has pointed to no disclosure within either patent that one of skill in the art would look to for such motivation or teaching. Again, the Examiner has not explained why one would look at device identified in the Lennon patent and be motivated to change them by applying the teaching of the McAlister patent. The Examiner has failed to identify how the cited reference suggests the desirability of modifying the device of the Lennon patent to include components from the McAlister patent. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."). Unless the Examiner provides an adequate explanation of the motivation to combine the cited references, it appears that she has used the claimed invention as a "template" to pick and choose the components of claims 7, 30, and 31 from the prior art. *Id.* quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)<sup>1</sup>. For at least these reasons, Applicants assert that a *prima facie* case of obviousness has not been made and that claims 7, 30, and 31 are patentable over the references.

2. The Examiner has not met the burden of establishing *prima facie* obviousness by failing to meet the burden of establishing that the prior art reference (or references when combined) teach or suggest all the claim limitations. And by failing to meet the burden of establishing that there would be a reasonable expectation of success associated with modifying the device of the Lennon patent to include components from the McAlister patent.

As discussed above with respect to claims 1 and 27, the Lennon patent does not teach or suggest all of the claim limitations. First, as described in the Lennon patent at col. 3, lines 25-26, the palm portion 41 "is formed of, or faced by, latex or other soft rubber 42." Contrary to the Examiner's assertion, elements 41 and 42 in the Lennon patent do not and cannot define a bag-like space that is at least partially enclosed, because elements 41 and 42 are either attached to one another ("faced by") or are actually the same element ("formed of"). Second, the Lennon patent does not disclose hooks in any form. Element 43 is described at col. 3, lines 27-28 as short

<sup>1</sup> "Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

fingers, teeth, bristles, or undulations. None of these disclose or even imply "hooks" as described by the Applicants at page 3 of the instant application. The McAlister patent does not correct these deficiencies because it does not teach or suggest a first material wherein the first material is hook material having hooks adapted to capture detritus, nor does it teach or suggest a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, particularly as those layers are defined by the Examiner. In addition to indicating why the cited references provide the requisite motivation and suggestion to be combined, the Examiner should also have indicated why the references provide the required expectation of succeeding in the endeavor. The Examiner has not shown that the references would have suggested to one of ordinary skill in the art that various components from the references should be combined and would have a reasonable likelihood of success. Both the suggestion and the expectation of success must be found in the cited references, not in Appellants' disclosure. In re Dow Chemical, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In view of the remarks set forth in this section, Applicants respectfully submit that claims 7, 30, and 31 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

### **3. Remarks on Paragraphs 24-28 of the Office Action mailed on July 27, 2004: Rejection of Claims 16, 19, 25, 29, and 32 as Obvious**

In the Office Action mailed July 27, 2004, the Examiner rejects claims 16, 19, 25, 29, and 32 as being unpatentable under 35 U.S.C. §103(a) over the Lennon patent in view of U.S. Patent No. 5,864,883 to Reo ("the Reo patent"). Applicants respectfully traverse the rejection.

Again, in order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. The Examiner bears the initial burden of establishing the *prima facie* case. See In re Piasecki, 223 U.S.P.Q. 785,787, 745 F.2d 1468, 1471 (Fed. Cir. 1984).



Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

1. The Examiner has not met the burden of establishing prima facie obviousness by failing to identify the motivation in the Lennon patent for modifying its teachings with the teachings of the Reo patent.

Claim 16 is directed to the device of claim 1, further comprising a sealing mechanism. Claim 19 is directed to the device of claim 16, wherein the sealing mechanism is an adhesive. Claim 25 is directed to the device of claim 1, wherein the first material consists essentially of hook material. Claim 29 is directed to the method of claim 27, further comprising sealing the mitt. Claim 32 is directed to the method of claim 30, further comprising sealing the device. Neither of the two cited references (the Lennon patent and the Reo patent) disclose the claimed devices. The Examiner improperly "picked and chose" the components from the two references using the claimed invention as a template in order to form the rejection. (The Applicants are unsure why claim 25 is included with this group.)

In the Office Action mailed July 27, 2004, the Examiner states "It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Reo of an adhesive sealing mechanism to the invention of Lennon, as such a mechanism would prevent detritus from falling out of the device after it was collected." In this Office Action, the Examiner attempts to provide an explanation of the motivation for combining the references. The Examiner's explanation is insufficient. The sole motivation asserted by the Examiner, one of preventing "detritus from falling out of the device after it was collected," does not appear in either of the cited patents. In fact, the device of the Lennon patent has no detritus within the device, as the detritus is collected on the outside of the device, so applying an adhesive sealing mechanism would perform no function whatsoever. There is, therefore, no motivation within the patents to apply the teachings of one to the other. The Examiner does not adequately state why one of ordinary skill would read the Lennon patent and then look to the Reo patent to convert the device to the another device to arrive at the device and method of claims 16, 19, 25, 29, and 32.

Further, the motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. In re Napier, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). The Examiner has pointed to no disclosure within either patent that one of skill in the art would look to for such motivation or teaching. Again, the Examiner has not explained why one would look at device identified in the Lennon patent and be motivated to change them by applying the teaching of the Reo patent. The Examiner has failed to identify how the cited reference suggests the desirability of modifying the device of the Lennon patent to include components from the Reo

Appl. No. 10/748,645  
 Amdt. dated October 27, 2004  
 Reply to Office Action of July 27, 2004

patent. In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."). Unless the Examiner provides an adequate explanation of the motivation to combine the cited references, it appears that she has used the claimed invention as a "template" to pick and choose the components of claims 16, 19, 25, 29, and 32 from the prior art. Id. quoting In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)<sup>2</sup>. For at least these reasons, Applicants assert that a *prima facie* case of obviousness has not been made and that claims 16, 19, 25, 29, and 32 are patentable over the references.

2. The Examiner has not met the burden of establishing prima facie obviousness by failing to meet the burden of establishing that the prior art reference (or references when combined) teach or suggest all the claim limitations. And by failing to meet the burden of establishing that there would be a reasonable expectation of success associated with modifying the device of the Lennon patent to include components from the Reo patent.

As discussed above with respect to claims 1 and 27, the Lennon patent does not teach or suggest all of the claim limitations. First, as described in the Lennon patent at col. 3, lines 25-26, the palm portion 41 "is formed of, or faced by, latex or other soft rubber 42." Contrary to the Examiner's assertion, elements 41 and 42 in the Lennon patent do not and cannot define a bag-like space that is at least partially enclosed, because elements 41 and 42 are either attached to one another ("faced by") or are actually the same element ("formed of"). Second, the Lennon patent does not disclose hooks in any form. Element 43 is described at col. 3, lines 27-28 as short fingers, teeth, bristles, or undulations. None of these disclose or even imply "hooks" as described by the Applicants at page 3 of the instant application. The Reo patent does not correct these deficiencies because it does not teach or suggest a first material wherein the first material is hook material having hooks adapted to capture detritus, nor does it teach or suggest a second layer including a second material, wherein the second layer has a second layer perimetric edge, and wherein at least a portion of the second layer perimetric edge is coupled to the first layer perimetric edge such that the first and second layers define a bag-like space that is at least partially enclosed, particularly as those layers are defined by the Examiner. In addition to indicating why the cited

<sup>2</sup> "Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

references provide the requisite motivation and suggestion to be combined, the Examiner should also have indicated why the references provide the required expectation of succeeding in the endeavor. The Examiner has not shown that the references would have suggested to one of ordinary skill in the art that various components from the references should be combined and would have a reasonable likelihood of success. Both the suggestion and the expectation of success must be found in the cited references, not in Appellants' disclosure. In re Dow Chemical, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In view of the remarks set forth in this section, Applicants respectfully submit that claims 16, 19, 25, 29, and 32 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

#### **4. Remarks on Paragraph 29 of the Office Action mailed on July 27, 2004: Rejection of Claims 17 and 18 as Obvious**

In the Office Action mailed November 22, 2002, the Examiner rejects claims 17 and 18 as being unpatentable under 35 U.S.C. §103(a) over the Lennon patent in view of the Reo patent and further in view of what is "old and notoriously well known in the art." Applicants respectfully traverse the rejection for the reasons stated above with respect to claims 16, 19, 25, 29, and 32.

In view of the remarks set forth in this section, Applicants respectfully submit that claims 17 and 18 are in condition for allowance and respectfully request favorable consideration and the timely allowance of those claims.

#### **5. Remarks on Paragraph 30 of the Office Action mailed on July 27, 2004**

In paragraph 30 of the Office Action mailed July 27, 2004, the Examiner objects to claims 9-11 and 21 as being dependent upon a rejected base claim, but also indicates that the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants appreciate the Examiner's acknowledgement of the allowable subject matter of claims 9-11 and 21. As described above, Applicants have added new claim 33 to include the subject matter of claims 9-11. In addition, Applicants have added new claim 34 to include the subject matter of claim 21. Therefore, Applicants respectfully submit that claims 33 and 34 are patentable over the references cited by the Examiner.

In conclusion, and in view of the remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable

Appl. No. 10/748,645  
Amdt. dated October 27, 2004  
Reply to Office Action of July 27, 2004

consideration and the timely allowance of pending claims 1-34. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-8863.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Respectfully submitted,

WENDY LYNN BEHNKE ET AL.

By: 

Randall W. Fieldhack  
Registration No.: 43,611  
Attorney for Applicant(s)

#### CERTIFICATE OF FACSIMILE TRANSMISSION

I, Randall W. Fieldhack, hereby certify that on October 27, 2004 this document is sent by facsimile transmission to the Commissioner for Patents via facsimile number (703) 872-9306.

By: 

Randall W. Fieldhack